

REMARKS

Claims 12-22 are pending in this application. By this Amendment, claims 12, 13, 16 and 19 are amended. No new matter is added. Support for the amendment to claim 12 can be found at, for example, page 4, lines 6-21. Support for the amendment to claims 16 and 19 can be found at, for example, page 5, lines 4-10 and 19-25. Support for the amendment to claim 13 can be found at, for example, page 4, lines 10-11. Reconsideration in view of the foregoing amendments and the following remarks is respectfully requested.

The Office Action objects to claim 12 under the assertion that the word "medium" appearing on line 3 of the claim is unnecessary. Claim 1 has been amended in view of this objection. Accordingly, Applicants respectfully request withdrawal of the objection.

The Office Action rejects claims 13, 16 and 19 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. As per the examiner's suggestion, claims 13, 16 and 19 have been amended to recite "an atomic percentage" of metals. Also, claims 16 and 19 have been amended to recite Markush Group phraseology as recommended by the Examiner. Accordingly, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 12, 14 and 17-20 under 35 U.S.C. §102(b) as being anticipated by European Patent No. EP 0 387 016 to Shigematsu et al. (hereinafter "Shigematsu"). The rejection is respectfully traversed.

Shigematsu does not disclose an optical recording medium "consisting of an atomic percentage of between 60% and 70% of zinc and between 30% and 40% of tellurium." Specifically, Shigematsu discloses a recording layer necessarily containing zinc, tellurium and germanium (Col. 4, lines 28-45). The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520 (C.C.P.A. 1931). See also, MPEP §2111.03. Thus, because Shigematsu necessarily contains

germanium, as disclosed by the proportion set forth at Col. 7, lines 38-40, Shigematsu comprises elements not specified in the claim. Accordingly, Shigematsu does not contain all features recited in claim 12 and the rejection is defective.

Claims 14 and 17-20 are allowable at least for their dependence on allowable base claims.

Accordingly, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 15 and 16 under 35 U.S.C. §103(a) as being obvious over Shigematsu, as applied to claim 12, further in view of either U.S. Patent No. 6,177,168 to Stevens (hereinafter "Stevens") or U.S. Patent No. 4,450,553 to Holster et al (hereinafter "Holster"). The rejection is respectfully traversed

Applicants do not concede that either Stevens or Holster teaches or discloses the features of dependent claims 15 and 16. However, it is unnecessary to separately discuss the features recited in dependent claims 15 and 16 given the existence of clear distinguishing features in independent claim 12. Furthermore, neither Holster nor Stevens cure the deficiencies of Shigematsu, as discussed above with respect to claims 12.

Thus, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 21 and 22 under 35 U.S.C. §103(a) as anticipated by Shigematsu, as applied to claims 20 and 12, further in view of U.S. Patent No. 5,354,590 Tamura et al. (hereinafter "Tamura"). The rejection is respectfully traversed.

Applicants do not concede that Tamura teaches or discloses the features of dependant claims 21 and 22. However, it is unnecessary to separately discuss the features recited in dependent claims 21 and 22 given the existence of clear distinguishing features in independent claim 12. Furthermore, Tamura does not cure the deficiencies of Shigematsu, as discussed above with respect to claims 12 and 20.

Thus, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 12 and 13 under 35 U.S.C. §103(a) over U.S. Patent No. 4,405,706 to Takahashi et al. (hereinafter "Takahashi"). This rejection is respectfully traversed.

Takahashi does not teach or suggest a rear face "wherein the inorganic material is tellurium and zinc alloy only consisting of atomic percentage of between 60% and 70% of zinc and between 30% and 40% of tellurium," as recited in claim 12. Specifically, the Office Action asserts that Takahashi discloses a recording layer containing a number of metals in addition to zinc and tellurium in undefined proportions (Takahashi, col. 3, line 52 to col. 4, line 19). The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally vary the atomic percentages of zinc and tellurium to "**whatever ratio desired by applicants.**" Aside from the obviously inappropriate reliance on hindsight suggested by the Examiner, Takahashi does not teach or suggest the specific proportions recited in claim 12. Furthermore, the Examiner's attention is directed to MPEP §2144.05(II)(B) which states (emphasis added):

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. *The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result- effective variable.*). See also In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) (prior art suggested proportional balancing to achieve desired results in the formation of an alloy).

Thus, because Takahashi does not recognize or identify that the amount of zinc and tellurium in an alloy as being a "result-effective variable," one of ordinary skill in the art would not have been motivated by Takahashi to obtain the specific alloy recited in claim 12.

Futhermore, Takahashi discloses a writing operation that utilizes phase change in the active layer (Col. 1, lines 16-28). The alloy cited in claim 12 is particularly adapted for use in a writing operation that uses mechanical deformations in the active layer. (See, for example, page 4, lines 2-4). Thus, because Takahashi is directed to an entirely different mechanism for performing a writing operation, one of ordinary skill in the art would not have been motivated by the teachings of Takahashi to achieve the recited alloy. Accordingly, the Examiner's assertions are wholly based on hindsight observations based on Applicants' specification, and are therefore defective. Thus, Takahashi does not teach or suggest a rear face "wherein the inorganic material is tellurium and zinc alloy only comprising an atomic percentage of between 60% and 70% of zinc and between 30% and 40% of tellurium," as recited in claim 12.

In addition, Shigematsu does not teach or suggest a rear face "wherein the inorganic material is tellurium and zinc alloy only comprising an atomic percentage of between 60% and 70% of zinc and between 30% and 40% of tellurium," as recited in claim 12. As discussed above in great detail, Shigematsu discloses a recording layer achieved by irradiation with an energy beam and comprised of zinc, tellurium and germanium in specified proportions (Col. 7, lines 28-45). Thus, because Shigematsu necessarily requires germanium, Shigematsu does not teach or suggest a rear face "wherein the inorganic material is tellurium and zinc alloy only comprising an atomic percentage of between 60% and 70% of zinc and between 30% and 40% of tellurium," as recited in claim 12.

Accordingly, the applied references, alone or in combination, do not teach or suggest all the features recited in claims 12 and 13. Therefore, Applicants respectfully request withdrawal of the rejection.

Claims 12-22 were provisionally rejected under nonstatutory obvious-type double patenting over Application 10/535,411. Applicants respectfully request the rejection be held in abeyance until the present invention is in condition for allowance.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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